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In re application of:

COTTEN *et al.*

Appl. No. 09/688,371

Filed: October 12, 2000

For: **Recombinant, Replication Defective
CELO Virus and CELO Virus
DNA**

Confirmation No. 5877

Art Unit: 1648

Examiner: Foley, S.

Atty. Docket: 0652.2150001/EKS/PAJ

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Reply To Restriction Requirement

Commissioner for Patents
Washington, D.C. 20231

Sir:

In reply to the Office Action dated December 19, 2001¹ (Prosecution History Paper No. 11), requesting an election of one invention to prosecute in the above-referenced patent application, Applicants hereby provisionally elect, with traverse, to prosecute the invention of Group I, represented by claims 1-16. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed.

The Examiner has restricted the claims into the following seven groups:

- I. Claims 1-16, drawn to a recombinant CELO virus or CELO virus DNA;
- II. Claims 17, 23 and 26-29, drawn to a method of making a recombinant CELO virus in a host animal;
- III. Claims 18-22, drawn to a method of making a recombinant CELO virus in a cell;

¹Pursuant to 37 C.F.R. § 1.7(a), Applicants submit that this Reply to Restriction Requirement is timely filed.

- IV. Claim 24, drawn to a method of making a recombinant CELO virus in an animal;
- V. Claims 30-33, drawn to a vaccine against infectious disease;
- VI. Claim 34, drawn to a CELO virus to make a tumor vaccine; and
- VII. Claims 35-40, drawn to a method of making a protein of interest.

(See Paper No. 11, page 2.) Applicants respectfully traverse the restriction requirement as it applies to Groups I-VI.

The Examiner asserts that the subject matter of Groups I-VI are distinct. (See Paper No. 11, pages 2-3.) Applicants note, however, that even where patentably distinct inventions appear in a single application, restriction remains improper unless the examiner can show that the search and examination of these groups would entail a "serious burden". (See M.P.E.P. § 803 at 800-4.) In the present situation, the Examiner has failed to make such a showing.

Applicants submit that a search of the recombinant CELO virus or CELO DNA claims would provide useful information for examining claims directed to methods of making a CELO virus. This is so because in many, if not most, publications which describe recombinant viruses and DNA, the method of producing the recombinant virus and/or DNA is likewise described. Thus, a search of the claimed CELO virus or CELO DNA would also provide the Examiner with art directed to the manner in which the claimed CELO virus or CELO DNA were made.

In addition, a search of the methods of producing a CELO virus or CELO DNA would be advantageous in finding information relating to the CELO virus/DNA itself. This

is because publications which disclose such methods usually do not do so in a vacuum - they typically describe the finished recombinant product.

Moreover, a search of vaccines comprising CELO virus would provide useful information regarding the CELO virus itself. Likewise, searching recombinant CELO virus would uncover art which discloses the use of the CELO virus as a vaccine.

In view of the above, Applicants submit that the searches for the claimed recombinant CELO virus/DNA, methods of making the same and vaccines comprising CELO virus would clearly be overlapping. Accordingly, Applicants request that the Examiner reconsider and withdraw the restriction requirement and examine the subject matter of Groups I-VI together in the present application.

Applicants further note that,

[w]here product and process claims drawn to independent and distinct inventions are presented in the same application, applicant may be called upon under 35 U.S.C. § 121 to elect claims to either the product or the process. . . . However, if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined.

M.P.E.P. § 821.04 at 800-63.

Claims 35-40 are method claims which are dependent upon, and thus include all the limitations of, elected claims 1 and 8. Applicants thus respectfully request that the Examiner rejoin and examine for patentability the subject matter of claims 35-40 if the elected claims are examined and found to be in condition for allowance.

Reconsideration and withdrawal of the Restriction Requirement, and consideration and allowance of all pending claims, are respectfully requested.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

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